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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,481	11/10/2003	Sonya S. Johnson	112703-306	5154
29156	7590	09/07/2007		
BELL, BOYD & LLOYD LLP			EXAMINER	
P.O. Box 1135			ROBERTS, LEZAH	
CHICAGO, IL 60690				
			ART UNIT	PAPER NUMBER
			1614	
			MAIL DATE	DELIVERY MODE
			09/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/705,481

Applicant(s)

JOHNSON ET AL.

Examiner

Lezah W. Roberts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6-11, 14-16, 18-20 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-11, 14-16, 18-20 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This Office action is in response to the Amendment filed June 25, 2007. All rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claims***

#### **Claim Rejections - 35 USC § 103- Obviousness (Previous Rejections)**

1) Claims 1, 4-10, 27-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al. (US 4,645,662) in view of Sturtz (US Plant 8,645). The rejection is maintained.

Applicant argues the references teach away from the instant invention and the references must be considered as a whole and those portions teaching away from the claimed invention must be considered. Nakashima explicitly teaches incorporating the oral composition with l-menthol as a flavor agent to mask the metallic and astringent taste of the aluminum. Therefore Nakashima teaches away from the disclosure of Sturtz, which is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. The present invention also specifically states "cooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents". Therefore Nakashima et al. teach away from Sturtz and the

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present invention. Neither one of the references discloses one of the listed heating agents. These arguments are not persuasive.

Although the primary reference, Nakashima, does encourage menthol as a flavor, the reference also discloses too much menthol can impart an excessive cooling taste. Therefore, it would have been obvious not to use too much menthol or peppermint oil and to replace the peppermint oil with Erospicata to ensure that the compositions did not have the excessive cooling taste without taking away the peppermint flavor. The claims recite the limitation cooling agents and although the instant disclosure defines cooling agents as non-menthol cooling agents, the claims give no indication that the menthol is excluded from the cooling agents or a recitation of cooling agents that are encompassed by the term cooling agents. Even if menthol was not considered the cooling agent, the compositions also may comprise carvone, methyl salicylate or eucalyptus oil, which has a cooling refreshing effect in the oral, throat or nasal cavity<sup>1</sup>. These may also be considered cooling agents. Nakashima does not actual teach away because it discloses too much menthol leads to an excessive cooling taste. Therefore as previously stated it would have been obvious to incorporate the erospicata oil to ensure an excess of menthol was not present. Pimento oleoresin is also capsicum oleoresin as state previously. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

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<sup>1</sup> Lages et al. (US 6,506,368), col. 3, line 64 to col. 4, line 5.

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only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The primary reference teaches the effect of excess menthol, therefore it would be obvious to modify the compositions to ensure that excess menthol is not used without taking away from the taste.

2) Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strobridge (US 5,015,464) in view of Sturtz (US Plant 8,645). The rejection is maintained.

Applicant argues the references teach away from the instant invention and the references must be considered as a whole and those portions teaching away from the claimed invention must be considered. Strobridge teaches the chewing gums must comprise an anti-plaque effective amount of menthol. In contrast, Sturtz is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. The present invention also specifically states, "cooling agents, for the purpose of the present invention, are defined as non-menthol cooling agents". Therefore Nakashima et al. teach away from Sturtz and the present invention. Applicant also argues the Examiners uses improper hindsight reasoning. These arguments are not persuasive.

Although menthol is incorporated in anti-plaque effective amounts, it would be obvious not to incorporate the menthol beyond this amount. It would be obvious to use

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the erospicata oil to ensure when flavoring is incorporated into the compositions, that additional menthol is not added by way of peppermint oil to decrease irritation that could occur by additional menthol introduced by the peppermint. The compositions also comprise eucalyptus oil and methyl salicylate, which also has cooling effects as stated above and may also be considered cooling agents. See Examiner's response above in regards to hindsight reasoning.

3) Claims 1, 4, 6-9, 11, 14-16, 18-19, 27-30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumamoto et al. (US 2002/0119231) in view of Sturtz (US Plant 8,645). The rejection is maintained.

Applicant argues the references teach away from the instant invention and the references must be considered as a whole and those portions teaching away from the claimed invention must be considered. Kumamoto et al. teaches warming compositions that exhibit long lasting warming effects. In contrast Sturtz is directed primarily toward a new and distinct variety of a mint plant, now known as erospicata. Erospicata can be used as a replacement for various cooling agent such as peppermint, to create a cooling composition without epithelial irritation caused by large amounts of menthol. The warming compositions of Kumamoto teach away from a combination with the cooling compositions of Sturtz. The present invention states that a heating agent may be used to potentiate the cooling agent to create an enhanced cooling flavor in an oral product also containing Erospicata. Therefore Kumamoto teaches away from Sturtz and the instant invention. These arguments are not persuasive.

The instant claims do not recite a limitation that the heating agent must be able to potentiate the cooling agent to create an enhanced cooling flavor. They recite a composition comprising a heating agent, a cooling agent and erospicata. Kumamoto discloses compositions comprising a mixture of warming and cooling agents therefore it encompasses the scope of the claims. The claims give no indication what type of cooling agent may be used and the specification defines the cooling agent as a non-menthol cooling agent. Therefore it may be concluded that the compositions of the reference comprising the mixture of warming agents and cooling agents would also produce an enhanced cooling flavor. It would have been obvious to use erospicata in place of peppermint as the flavoring in order to inhibit epithelial irritation caused by menthol as disclosed by Sturtz. Kumamoto cannot be teaching away from the instant claims because it discloses cooling agents may be used in conjunction with the warming agents, which encompasses the claims.

Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 are rejected.

No claims allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts  
Patent Examiner  
Art Unit 1614



Frederick Krass  
Primary Examiner  
Art Unit 1614

